

REMARKS

I. Introduction

Applicants respectfully request acknowledgement of the receipt for, and consideration of the Information Disclosure Statement filed on October 24, 2006.

For the reasons set forth below, Applicants respectfully submit that all pending claims are in condition for allowance.

II. The Rejection Of Claims 42-45, 48-50, 52-55 And 57 Under 35 U.S.C. § 103

Claims 42-45, 48-50, 52-55 and 57 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shigehiro et al. (USP No. 6,741,387) in view of Yamada et al. (USP No. 5,965,064). Applicant respectfully traverses this rejection for at least the following reasons.

With regard to the present invention, claims 42, 44 and 57 each recite, in-part, a display device comprising: a pair of substrates disposed opposite to each other, at least one of which is transparent; a plurality of particles having an electrostatic property contained in a gaseous phase provided between the pair of substrates; first and second electrodes provided for each of pixels arranged in a matrix for driving the particles; and a voltage applying portion for applying voltage to the first and second electrodes in accordance with an image signal, wherein the particles each comprise a parent particle as a core ... and when voltage is applied to the first and second electrodes by the voltage applying portion, the particles are caused to travel between the first and second electrodes in accordance with the voltage applied so as to display an image corresponding to the image signal.

It was alleged in the pending Office Action that the teachings of Yamada in combination with Shigehiro renders claims 42, 44 and 57 of the present invention obvious. Specifically, the

Examiner states that “it would have been obvious to one having ordinary skill in the art...to combine the device of Shigehiro et al. with the parent particles of Yamada et al. for the purpose of a high dynamic speed motion the gaseous phase.”

However, the combination of Shigehiro and Yamada proposed by the Examiner is improper. As noted in the Office Action, the display element disclosed in Figs. 12 and 13 of Shigehiro comprises a plurality of particles 13 and 14 having an electrostatic property contained in a gaseous phase provided between a pair of substrates 10 and 11, wherein particles are caused to travel between the first and second electrodes 403 and 404 in accordance with the voltage applied, so as to display an image to the image signal.

Yamada teaches an anisotropically electroconductive adhesive film comprising electroconductive particles (abstract). The particles disclosed in Yamada that are used in the electroconductive adhesive film are coated with an *electrically insulating resin* (see, Yamada, col. 3, lines 46-48 and col. 12, lines 54-57). Thus, since the particles are coated with an electrically insulating resin, they would not be attracted to oppositely charged counterparticles, and accordingly, would not be able to travel between the substrates when a voltage is applied. Accordingly, the use of the particles of Yamada would render the invention of Shigehiro inoperable. Furthermore, the particles in Yamada are intended to remain set and immovable in the adhesive film, whereas in contrast, Shigehiro requires dynamic movement of particles across the substrates when a voltage is applied. As is well known in patent law, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). As such, Applicants respectfully submit that the proposed combination is improper.

Moreover, the Examiner has provided no teaching or suggestion to suggest the desirability to combine the two above cited references. Applicants refer the Examiner to § 2141 of the MPEP entitled, “*Basic Considerations Which Apply to Obviousness Rejections*”, part (B) which states, “The references must be considered as a whole and **MUST** suggest the desirability and thus the obviousness of making the combination.” As stated above, the particles disclosed in Yamada comprise an electroconductive adhesive film, whereas Shigehiro concerns a display element. As the two references are in different technical fields, it would not be readily obvious to combine them, nor is the invention in Yamada reasonably pertinent to the particular problem with which Shigehiro is concerned. Furthermore, as the particles of Yamada are coated with an electrically insulating resin and set in an adhesive resin, they would not be particularly useful as particles in the use as disclosed in Shigehiro, as the particles cannot move across substrates as required by Shigehiro. Thus, without any suggestion to combine the above cited references, and in addition to the argument recited above AGAINST combining the references, Applicants submit that the requisite motivation to combine Shigehiro and Yamada to substantiate a rejection under 35 U.S.C. § 103 has not been demonstrated. As such, Applicants submit that the proposed combination is improper.

Accordingly, it is respectfully requested that the § 103 rejection of claim 42, 44, 57, and any pending claims dependent thereon be withdrawn.

**III. All Dependent Claims Are Allowable Because The
Independent Claim From Which They Depend Is Allowable**

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 42, 44 and 57 are patentable for the reasons set forth above, it is respectfully submitted that all pending dependent claims are also in condition for allowance.

IV. Conclusion

Having fully responded to all matters raised in the Office Action, Applicant submits that all claims are in condition for allowance, an indication of which is respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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